

Office Action Summary

Application No.

09/523405

Applicant(s)

Johnson

Examiner

Akers G

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/10/00.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2, 3 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-49 are rejected under 35 USC 103(a) as unpatentable over Williams(US Pat. No:6,016,484) in view of Basch(US Pat. No: 6,119,103).

3. As per claims 1-49 Williams discloses the invention substantially as claimed including in a method of charging a payment transaction to a customer(Fig 5)(Fig 5A)(Fig 5B) as well as operation by means of electronic communication(Abstract)(Summary) as well as electronic payments on telephony based response(col 1 line 66-col 2 line 8). Williams further discloses sending forms over the Internet to a Web browser operated by a customer(Figs 9-34). Williams provides a detailed payment processing framework(ref) including soliciting from a customer a plurality of payment instruments(col 17 lines 1-6)(col 22 lines 13-54)(Fig 10) as well as obtaining from the customer information identifying a payment instrument where the customer is willing to allow payment by an identified payment instrument(col 17 lines 7-11) and identifying instruments utilizing different funding sources(col 22 lines 13-54)(Fig 10/1020/1030/1040) as

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well as receiving funds for the payment of said transaction using the identified payment instrument(col 17 lines 25-44) as well as updating records containing payment instrument selection criteria(col 10 lines 33-48)(col 12 lines 53-65)(col 13 lines 8-25)(col 14 line 64-col 15 line 5) and charging a payment transaction to a customer utilizing a server on the Internet(Fig 1A)(Fig 1B).Williams teaches transmission to a payment network of at least the selected payment instrument and transaction amount(col 14 lines 5-17)(col 17 lines 1-30) as well as receiving payment confirmation from a payment network(col 17 lines 42-44) an receiving explicit authorization from a customer to process a payment transaction using a selected payment instrument(col 31 lines 29-48). Williams does not specifically disclose the identification of at least two payment instruments from which one payment instrument is automatically selected by a transaction evaluator based on the relative economic utility of the instruments.Basch teaches for at least two payment instruments, submitting information about the instruments to a computer-implemented transaction evaluator(col 5 lines 1-4)(col 5 lines 47-61)(col 12 line 66-col 13 line 8)(col 17 lines 18-55)including estimating risk associated with another payment instrument(col 6 lines 21-39) and a server used in a transaction evaluation process(Fig 4).Basch teaches receiving an automatic selection of one of the instruments based on the relative economic utility of the instruments(col 9 line 38-col 10 line 13) as well as relative scores for transactiions which would have provided a comparative index for relative economic utility(col 13 lines 2-8).Basch further discloses relative financial risk scores(col 9 lines 23-61) for authorizing or denying transaction requests.It would have been obvious to skilled in the art at the time of the invention to combine

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Williams in view of Basch to teach the disclosure. The motivation to combine is to teach an economically beneficial means of selecting a payment instrument to minimize risk of financial loss as enumerated by Basch(col 3 lines 33-37).

Conclusion

4. THIS ACTION IS MADE NON-FINAL.

5. Any questions concerning this communication should be addressed to the primary examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the primary examiner are unsuccessful, the primary examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.



August 10, 2003

DR. GEOFFREY R. AKERS, P.E.
PRIMARY EXAMINER